



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,475	05/24/2001	John B. Lowe	209013US55 CONT	2187

22850 7590 01/15/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

PROUTY, REBECCA E

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 01/15/2003

62

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863,475

Applicant(s)

Lowe

Examiner

Rebecca Prouty

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 4, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-52 is/are pending in the application.
- 4a) Of the above, claim(s) 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-26 and 30-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

Art Unit: 1652

Claims 1-8 have been canceled. Claims 9-52 are at issue and are present for examination.

Applicant's election with traverse of Group I, Claims 9-26 and 30-52 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there would be no burden of search for the coexamination of both groups simultaneously. This is not found persuasive because while the search necessary for examination of the two groups overlaps it is not coextensive, examination of Group II would require search of subclasses unnecessary for the search of Group I, for example 424/94.5 and 435/97.

The requirement is still deemed proper and is therefore made FINAL.

Claims 27-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Applicant is advised that should claims 10, 13, and 17 be found allowable, claims 19, 23, and 26 respectively will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after

Art Unit: 1652

allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Each of Claims 10 and 19 encompass nucleic acids comprising SEQ ID NO:3, Claims 13 and 23 encompass vectors comprising SEQ ID NO:3, and Claims 17 and 26 encompass host cells transformed with vectors comprising SEQ ID NO:3.

Claims 36, 41, 46 and 51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitation of the minimal catalytic domain of the galactosyltransferase of SEQ ID NO:4 as amino acids 43-361 in these claims lacks support in the application as filed. The specification discloses the minimal catalytic domain of the galactosyltransferase of SEQ ID NO:4 as amino acids 63-394.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1652

Claims 9-26 and 30-52 are rejected under 35 U.S.C. 102(a) as being anticipated by Larsen et al.

Larsen et al. teach a murine nucleic acid identical to SEQ ID NO:3 which encodes SEQ ID NO:4, and the cloning and expression of this nucleic acid to produce the encoded protein and a Protein A fusion to amino acids 63-394 encoding the minimal catalytic domain of this galactosyltransferase.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Joziassse et al. disclose a bovine nucleic acid encoding an  $\alpha$ -1,3-galactosyltransferase with substantial homology to SEQ ID NO:4. However, as the encoded proteins have only 72% identity, it is not expected that the nucleic acid disclosed by Joziassse et al. will hybridize to the nucleic acid of SEQ ID NO:3 under the high stringency conditions of Claims 33, 38, and 43.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Application/Control Number: 09/863,475

Page 5

Art Unit: 1652

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "Rebecca Prouty".

Rebecca Prouty  
Primary Examiner  
Art Unit 1652